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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/669,119
Filing Date: September 22, 2003
Appellant(s): KELLY ET AL.

Sabra-Anne R. Truesdale
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the reply brief filed 15 October 2008.

Responsive to the reply brief filed 15 October 2008, a supplemental Examiner's Answer is set forth below:

Response to Argument

Appellant notes (page 4 of the reply brief) that the examiner has argued that certain language in the *Graff* decision (quoted in the second paragraph on page 4 of the reply brief) supports the examiner's position in the present appeal. Appellant then argues (last paragraph of page 4 of the reply brief) that *Graff* should be distinguished because in *Graff*, no notice of broadening was provided to the public within the 2-year period following the issue date of the original *Graff* patent, whereas in the present appeal, a broadening reissue application had been filed within the two year period following the issuance of the original patent.

However, appellant does not explain why 35 U.S.C. 251 should be read as permitting the filing of a reissue application to correct an error of claiming too narrowly that the public had not been apprised of during the two year period following the issuance of an original patent, merely because the public had been informed that the original reissue patent was claiming too narrowly with respect to an entirely different claim limitation. Appellant's statement (page 2 of the reply brief) that the court in *Doll* "was merely addressing whether the declaration was adequate, after dealing with the

primary issue about whether claims may be broadened outside the scope of the original declaration (citing *Doll*, 419 F.2d at 928)" does not address the issue in this appeal.

This is clear from the fact that in *Doll*, no continuing reissue application was before the court. The decision of the court in *Doll* is based on two propositions:

(1) That all of the reissue claims presented in *Doll* were presented in a single reissue application that had been filed within two years, so that the public had been informed of an intent to broaden in that application. This fact forms the legal basis for the court's decision because, as stated at 419 F.2d 928, the *Doll* court found that per a reading of the P.J. Federico's commentary on 35 U.S.C. 251, that the statute required filing of a reissue application within two years, as opposed to requiring that a given broadening claim "must be claimed" within two years (" ... it appears clear that the language 'applied for' refers to filing of an application.").

(2) "If the claims of appeal are broader in scope than claims 20-31, originally presented, as all agree, it is clear that none of the patent claims afforded patent coverage of the scope of claims 32-35, 42 and 43 either. We are unable to perceive any other objections by the board to the oath in question. No particular defect has been singled out or commented upon by the board." [Doll, 419 F.2d at 928, emphasis added.]

In the present appeal, the broadened claims were not presented in an application "applied for" within two years of the issue date of the original patent, and also do not address the specific error (the specific manner in which the patent claims were alleged to be too narrow) that was specified in the original reissue application that was "applied for" within two years.

It is respectfully requested that the present panel of the BPAI "single out" the particular defect alleged in the present reissue application, compare it to the defect alleged in the parent reissue application, and then distinguish *Doll* on the basis of the specific differences between those defects, and also on the fact that the two different defects appear in different reissue applications, where the present (second) reissue application that was not "applied for" more than two years after the issue date of the original patent.

The BPAI should not approve of appellant's attempt to correct "errors" by allowing broadening in a continuing reissue application "applied for" more than two years after the issue date of the original patent merely because an earlier reissue application "applied for" within two years requested correction of different broadening errors, any more than the BPAI would approve of a reissue application filed to reissue a reissue patent, where the reissue application is "applied for" more than two years after the grant of the original patent, and is directed to broadening original patent claims in a

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manner never raised or presented in the issued reissue patent, even though the reissue patent itself broadened original patent claims in a totally different manner.

Appellant may file another reply brief in compliance with 37 CFR 41.41 within two months of the date of mailing of this supplemental examiner's answer. Extensions of time under 37 CFR 1.136(a) are not applicable to this two month time period. See 37 CFR 41.43(b)-(c).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Glenn A. Auve/
Primary Examiner, Art Unit 2111

**A Technology Center Director or designee has approved this
supplemental examiner's answer by signing below:**

/Wendy Garber/
Director, Technology Center 2100*